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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,181	05/23/2000	Paul Lapstun	NPA075US	9167
24011	7590	08/09/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,181

Applicant(s)

LAPSTUN ET AL.

Examiner

Lalita M. Hamilton

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Summary

On January 25, 2005, an Office Action was mailed to the Applicant rejecting claims 1-65. On March 14, 2005, the Applicant responded by amending claims 1, 4-5, 29, 32-33, and 60-65.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Landry (5,649,117) in view of Kasabach (6,456,749).

Landry discloses the invention substantially as claimed (col.6, line 30 to col.7, line 30; col.9, lines 5-40; col.22, line 60 to col.23, line 37; col.26, lines 49-60; col.27, lines 15-37; and col.35, line 10 to col.36, line 20); however, Landry does not disclose a sensing device operated by the user, the indicating data being indicative of the identity

Art Unit: 3624

of the form and of a position of the sensing device relative to the form, the indicating data having been generated by the sensing device using at least some of the coded data it sense when placed in an operative position relative to the form, and identifying the indicating data having been generated by the sensing device using at least some of the coded data it sensed when placed in an operative position relative to the form, and identifying from the indicating data; receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data, and identifying, in the computer system and from said movement being at least partially within said at least one zone; interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter; the parameter is a text parameter of the bill paying transaction, identifying, in the computer system, that the potential purchaser has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter; converting handwritten text to computer text; a payer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter; the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as belonging to a particular potential purchaser; sensing device includes a marking nib; the sensing device captures data, time-varying location data forming a series of strokes from which digital ink is derived; the digital ink derived from a signature zone being used to recognize or authenticate a user; or the sensing device comprises a

Art Unit: 3624

wireless pen interface and a transmission of digital ink from the wireless pen interface further comprises bio-metric information derived from bio-metric data captured by the pen interface. Kasabach teaches a method and corresponding system for recognition of writing and communications comprising a sensing device operated by the user, the indicating data being indicative of the identity of the form and of a position of the sensing device relative to the form, the indicating data having been generated by the sensing device using at least some of the coded data it sense when placed in an operative position relative to the form, and identifying the indicating data having been generated by the sensing device using at least some of the coded data it sensed when placed in an operative position relative to the form, and identifying from the indicating data (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data, and identifying, in the computer system and from said movement being at least partially within said at least one zone (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); the parameter is a text parameter of the bill paying transaction, identifying, in the computer system, that the potential purchaser has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6,

Art Unit: 3624

line 65; and col.7, lines 15-65); converting handwritten text to computer text; a payer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter; the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as belonging to a particular potential purchaser (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); sensing device includes a marking nib (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); the sensing device captures data, time-varying location data forming a series of strokes from which digital ink is derived(col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); the digital ink derived from a signature zone being used to recognize or authenticate a user (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65); and the sensing device comprises a wireless pen interface and a transmission of digital ink from the wireless pen interface further comprises bio-metric information derived from bio-metric data captured by the pen interface (col.3, line 8 to col.4, line 57; col.5, line 10 to col.6, line 65; and col.7, lines 15-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a sensing device operated by the user, the indicating data being indicative of the identity of the form and of a position of the sensing device relative to the form, the indicating data having been generated by the sensing device using at least some of the coded data it sense when placed in an operative position relative to the form, and identifying the indicating data having been generated by the sensing device using at least some of the coded data it sensed when

Art Unit: 3624

placed in an operative position relative to the form, and identifying from the indicating data; receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data, and identifying, in the computer system and from said movement being at least partially within said at least one zone; interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter; the parameter is a text parameter of the bill paying transaction, identifying, in the computer system, that the potential purchaser has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter; converting handwritten text to computer text; a payer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter; the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as belonging to a particular potential purchaser; sensing device includes a marking nib; the sensing device captures data, time-varying location data forming a series of strokes from which digital ink is derived; the digital ink derived from a signature zone being used to recognize or authenticate a user; and the sensing device comprises a wireless pen interface and a transmission of digital ink from the wireless pen interface further comprises bio-metric information derived from bio-metric data captured by the pen interface, as taught by Kasabach into the invention to disclosed by Landry, to allow for information that the user is filling in on a form to be uploaded into a form for Internet bill paying.

Response to Arguments

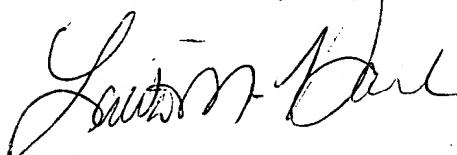
Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH